# APPENDIX B

## TO EXHIBIT 1

**Ron Katznelson**

**From:** Clarke, Robert (OPLA) [Robert.Clarke@USPTO.GOV]

**Sent:** Thursday, May 10, 2007 10:45 AM

**To:** Ron Katznelson

**Cc:** Doll, John

**Subject:** RE: Patenting trends and examination workload reduction

The most recent discussions were via a series of town hall meetings.

Deferred examination was also topic 11 of an advance notice of proposed rulemaking available at:
http://www.uspto.gov/web/offices/com/sol/notices/fr981005.htm Comments to this advance notice are available at:
http://www.uspto.gov/web/offices/pac/dapp/opla/comments/anpr/

I hope this is helpful.

Rob

-----Original Message-----
**From:** Ron Katznelson [mailto:rkatznelson@roadrunner.com]
**Sent:** Wednesday, May 09, 2007 2:03 PM
**To:** Clarke, Robert (OPLA)
**Cc:** Doll, John
**Subject:** RE: Patenting trends and examination workload reduction

Hello Rob,

Thanks for the pointers and I am sorry that my manuscript is so long...
Is there a record of past 'Examination-On-Request' proposals and objections to them? I could not find anything on the subject. I am interested to know what aspects of these proposals were objectionable. Surely, patentees can only find advantages in the system because they can always request examination upon filing. Objections due to term extension under the old patent term practice of 17 years after grant are no longer relevant after 1995. If objections came from those who were concerned that the public might be harmed by not having early resolution of patent rights in cases where the applicant takes the full allotted period for requesting examination, that concern is largely moot in my proposal. It permits ***any third party*** to trigger an examination after publication and thus compel the applicant (and the USPTO) to engage in early prosecution in much the same way as is done today. It is my prediction, however, that even then, a very large number of cases would receive no requests for examination from any party and that at least 20% of originally submitted claims would not have to be examined at all. In addition, it is very likely that amended claims submitted in such Examination Request would be more ripe for examination after the applicant will have had more time to learn of the prior art. This latter aspect is perhaps just as important for examination workload efficiency and quality.

Lastly, to the extent that statutory language is required for such practice, due to Congress' present patent reform initiatives, this is the time to do it and not later. I believe this system has a potential for USPTO workload relief ***immediately*** in a scale that dwarfs any controversial and illusory relief sought from other possible tweaks of claim and continuations limitation rules.

Best,

Ron

-----Original Message-----
**From:** Clarke, Robert (OPLA) [mailto:Robert.Clarke@USPTO.GOV]
**Sent:** Wednesday, May 09, 2007 9:30 AM
**To:** rkatznelson@roadrunner.com
**Cc:** Doll, John
**Subject:** RE: Patenting trends and examination workload reduction

Ron,

The Office plans to hold public meetings on alternative patent products and procedures in the near term. During these meetings I anticipate that we would again consider examination-on-request like proposals even though there was considerable opposition to deferred examination the last time it was considered by the Office.

A small point. While I have not reviewed the article in its entirety, the publication of patent applications statute was not effective till 11/29/2000, while it was enacted in 1999.

Rob

Robert A. Clarke
Deputy Director & Acting Director
Office of Patent Legal Administration
571 272 7735

-----Original Message-----
**From:** Ron Katznelson [mailto:rkatznelson@roadrunner.com]
**Sent:** Tuesday, May 08, 2007 3:55 PM
**To:** Clarke, Robert (OPLA)
**Cc:** Doll, John
**Subject:** Patenting trends and examination workload reduction

Dear Robert Clarke,

Attached is a final draft of my paper on continuations and patenting trends. It is substantially different from the version that I sent you last year during the continuation comment period. In this paper I found new grounds and justifications for the USPTO to adopt an "Examination-by-Request" regime, as it takes advantage of the increased number of claims that are obsolete at the time a patent is granted. Now, the USPTO is increasingly examining claims that applicants ultimately will not need examined. The last section of my paper (Conclusion) explains why the USPTO stands to experience more than 20% reduction in examination burden ***immediately*** upon adopting the "Examination-By-Request" procedure. I am surprised that the USPTO has not suggested that Congress look into such examination regime in its current patent reform effort. It is not too late to do so now. My proposal is slightly different than the system used at the EPO or JPO in that after publication, any party can trigger an examination proceeding and not just the applicant. That way, the public is not harmed by dormant applications whose applicant is delaying examination.

Given the fact that in the coming decades, the number of applications is expected to arrive at a growth rate that doubles every 6.5 years, I cannot envision the USPTO being able to handle the examination burden without moving to an "Examination-by-Request" system.

I would appreciate any comments you or your colleagues might have.

Best regards,

- Ron

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